

REMARKS

Summary of Office Action

Claims 1, 2, 6-10, 12-18, 20-24, 26-37, 40-43, 45-48, and 50-63 are pending in the application.

The Examiner has rejected claims 1, 2, 6-10, 12-18, 20-24, 26-34, 36, 37, 40-43, 45-48, and 50-63 under 35 U.S.C. § 103(a) as being unpatentable over Srinivasan et al. U.S. Patent No. 6,357,042 ("Srinivasan") in view of Reilly et al. U.S. Patent No. 5,740,549 ("Reilly"). Claim 35 stands rejected under 35 U.S.C. § 103(a) over Srinivasan. These rejections are respectfully traversed.

Summary of Applicants' Reply

Applicants have amended independent claims 1, 18, 32, 36, 37, 43, 48, and 53 to more particularly define the invention. Support for the amendments can be found, for example, on page 12, lines 19-30 of applicants' specification.*

Reconsideration of this application in light of the amendments and the following remarks is hereby respectfully requested.

Telephonic Interview Summary

On March 12, 2009, a telephonic interview took place between the Examiner and the undersigned. The undersigned wishes to thank the Examiner for the courtesies extended during the telephonic interview.

During the telephonic interview, undersigned and the Examiner discussed the 35 U.S.C. § 103(a) rejection. In

* The recitation of support for independent claims 1, 18, 32, 36, 37, 43, 48, and 53 is not intended to be exclusive. There may be support found elsewhere in the specification.

particular, the undersigned argued that Reilly does not show selecting an advertisement for display based on a comparison of metadata associated with a plurality of advertisements with metadata associated with an object contained in media. Instead, Reilly shows selecting advertisements in a rotating order from a group of pre-assigned advertisements. The Examiner suggested applicants amend the claims to more clearly recite that each advertisement in the plurality of advertisements is associated with its own metadata.

Applicants' Reply to the Prior Art Rejection

Applicants have amended independent claims 1, 18, 32, 36, 37, 43, 48, and 53, as well as dependent claims 12-14, 26-28, 54-57, and 59-62, to more particularly define the invention. These amendments do not add new matter and are fully supported by the original specification.

Applicants' amended independent claims 1 and 37 are directed toward *inter alia* a method and system for providing an advertisement selected from a plurality of advertisements each associated with its own metadata. User equipment receives media with at least one object, as well as metadata associated with the media, the object, and each of the plurality of advertisements. The user equipment also receives a subplurality of advertisements selected based on the metadata associated with the media. After a user selection of the object is received, the metadata associated with the object is compared with the metadata associated with each of the subplurality of advertisements, and one of the subplurality of advertisements is selected based on the comparison.

For example, applicants' amended independent claim 1 provides a systematic metadata-based approach for providing an advertisement in response to a user selection of a media object. This systematic approach includes receiving the media

and object (e.g., a movie scene displaying an actor's jacket) as well as metadata associated with the media (e.g., a list of program sponsors), metadata associated with the object (e.g. the clothing brand of the jacket), and metadata associated with each of a plurality of advertisements (e.g., descriptions of advertised products and services). A subplurality of advertisements is selected based on the metadata associated with the media (e.g., advertisements related to products and services offered by the program sponsors) and received on user equipment. After a user selection of the object is received (e.g., the user clicks on the actor's jacket), the metadata associated with the object is compared with the metadata associated with each of the subplurality of advertisements, and one of the subplurality of advertisements is selected based on the comparison (e.g., an advertisement for a jacket provided by a program sponsor similar to the one displayed in the media). This systematic approach can be used to effectively provide targeted advertisements to a user through metadata-based advertisement selection.

To make out a *prima facie* case of obviousness, the cited references must teach or suggest all the claim limitations of the rejected claim (MPEP § 2143). However, taken alone or in combination neither Srinivasan nor Reilly shows or suggests all of the features recited by applicants' independent claims. Thus, the rejections under 35 U.S.C. § 103(a) should be withdrawn.

Srinivasan refers to a method and apparatus for multiplexing separately-authored metadata for insertion into a main video data stream. Specifically, Srinivasan discusses a video advertisement system that provides personalized advertisements based on user profile information and, in some embodiments, inserts internet addresses (URLs) for the advertisements "as metadata" into the video stream provided to the user (Srinivasan, col. 29, ll. 10-14, col. 32, ll. 22-31). The inserted URLs are then used by the playback unit to "pull

the relevant ad or ads from the appropriate destinations in the Internet" (*Id.*, ll. 32-34).

The Examiner contends that Srinivasan shows (1) receiving metadata associated with a plurality of advertisements, (2) comparing metadata associated with a selected object with the metadata associated with the plurality of advertisements, and (3) selecting one of the plurality of advertisements at the user equipment based on the comparison. The Examiner concedes that Srinivasan does not show that the plurality of advertisements were received at user equipment prior to the selection of the one advertisement, but alleges that Reilly can be combined with Srinivasan to show such a feature.

Reilly refers to an information and advertising distribution system that includes a database of information items and advertisements "each categorized so that each has an associated information category" (Reilly, col. 2, ll. 62-66). Periodically, "at least a subset" of the information items and advertisements are provided to subscriber workstations and stored in local memory (Reilly, col. 3, ll. 5-11). When a subscriber views a news item, "[t]he advertisement image shown is selected on the basis of the information category associated with the news item" (Reilly, col. 13, ll. 62-64). As more than one advertisement may be associated with an information category, "the advertisements are selected in rotating order among the advertisements assigned to each information category" (Reilly, col. 14, ll. 3-5). As shown in Reilly's FIG. 8, both the news items and advertisements are organized as "linked lists" so as to create "separate queues" of news items and advertisements for each information category (Reilly, col. 12, ll. 6-14). In other words, once an information category is identified, the queue of assigned advertisements is accessed and each advertisement is displayed in sequence.

The Examiner contends that the combination of Srinivasan and Reilly shows (1) receiving metadata associated with a plurality of advertisements, (2) receiving the plurality of advertisements at the user equipment, (3) comparing metadata associated with a selected object with the metadata associated with the plurality of advertisements, and (4) selecting one of the plurality of advertisements from the local store at the user equipment based on the comparison. Applicants respectfully disagree and further submit that the combination of Srinivasan and Reilly does not show or suggest selecting an advertisement from a plurality of advertisements based on the metadata associated with each of the advertisements. Specifically, applicants submit that the combination of Srinivasan and Reilly does not show or suggest selecting a subplurality of advertisements based on metadata associated with the media, and further selecting one of the subplurality of advertisements based on a comparison that includes the metadata associated with each of the subplurality of advertisements, as specified in applicants' amended claims.

A. Srinivasan does not Show or Suggest Selecting an Advertisement Based on a Comparison of Metadata Associated with each of a Subplurality of Advertisements with Metadata Associated with a User Selected Object in Media

The Examiner contends that Srinivasan shows selecting an advertisement based on a comparison of metadata associated with each of a subplurality of advertisements with metadata associated with an object selected by a user. In particular, the Examiner cites Srinivasan's discussion of associating advertisements "with a tracked object" and an advertisement engine configured to retrieve URLs for advertisements and that "inserts the URLs in the video stream as metadata" (Srinivasan, col. 6, ll. 14-15, col. 32, ll. 26-30). In addition, the Examiner cites numerous

references within Srinivasan each indicating that a user can interact with an object and that such interaction may trigger a remote server to provide "additional network-stored information" about the object to user equipment, including information from advertisers (Srinivasan, col. 7, ll. 25-30, col 12, ll. 20-35, col. 22, ll. 1-10). In other words, the Examiner contends that Srinivasan refers to a video stream that includes the URLs of advertisements, and an object with associated advertisements that, when selected, can provide additional network-stored information. The Examiner argues that these features show receiving metadata associated with a plurality of advertisements and selecting an advertisement based on a comparison of that metadata with metadata associated with a user selected object.

Applicants respectfully submit, however, that Srinivasan does not show or suggest comparing at user equipment metadata associated with an object selected by the user with metadata associated with each of a subplurality of advertisements and selecting one of the subplurality of advertisements based on the comparison, as specified in applicants' independent claims. Specifically, Srinivasan does not show or suggest using, in any away, metadata associated with advertisements in order to select a particular advertisement. Instead, in Srinivasan, advertisements are selected "based on selected profile information originally provided by the end user" (Srinivasan, col. 29, ll. 9-15). Furthermore, while Srinivasan refers to an advertisement engine configured to insert URLs into a video stream "as metadata," these URLs are used only to direct the playback unit to the location of "the relevant" advertisements on the Internet (Srinivasan, col. 32, ll. 22-40). In other words, Srinivasan uses the URLs in order to specify the location of pre-selected advertisements, not to provide a mechanism for selecting the advertisements in the first place. Indeed, Srinivasan specifies, "In practicing the invention advertisers

may prepare a variety of video ads targeting various user profiles, and the ad server will use stored profiles and user interactivity to select the appropriate ads to be inserted" (Srinivasan, col. 31, ll. 50-57).

In contrast to Srinivasan, the applicants' approach, as defined by amended independent claim 1, is directed to selecting an advertisement based on a comparison of metadata associated with a selected object with metadata associated with each of a subplurality of advertisements, wherein the subplurality of advertisements itself is selected using metadata associated with the media provided to the user. Srinivasan, on the other hand, does not select an advertisement using metadata associated with each of a subplurality of advertisements and makes no comparisons using metadata at all. Thus, Srinivasan does not show or suggest all of the elements of applicants' amended independent claims.

Moreover, as discussed above, a user selection of an object in Srinivasan may trigger the transfer of remotely stored information. This remotely stored information, which Examiner alleges is metadata associated with the object, is not stored locally, in contrast to applicants' claimed invention. Thus, for this reason too, Srinivasan does not show or suggest all of the elements of applicants' amended independent claims.

B. Reilly does not Show or Suggest Selecting an Advertisement Based on a Comparison of Metadata Associated with each of a Subplurality of Advertisements with Metadata Associated with a User Selected Object in Media

The Examiner contends that Reilly shows selecting an advertisement based on a comparison of metadata associated with each of a subplurality of advertisements previously received and stored on a user's computer with metadata associated with an object selected by the user. In

particular, the Examiner cites Reilly's discussion of selecting advertisements "on the basis of the information category associated with the news item being viewed" (Reilly, col. 13, ll. 61-64) in order to argue that Reilly compares the information category of a selected news item to the information category of a plurality of advertisements and selects one of the advertisements "whose associated metadata matches the associated metadata of the selected object" (Office Action, page 4).

Applicants respectfully submit, however, that Reilly does not show or suggest receiving metadata associated with each of a plurality of advertisements, wherein each advertisement in the plurality of advertisements is associated with its own metadata, as specified in applicants' independent claims. Instead, as discussed above in reference to Reilly's FIG. 8, both the news items and advertisements are organized as "linked lists" so as to create "separate queues" of news items and advertisements for each information category (Reilly, col. 12, ll. 6-14). That is, rather than provide metadata associated with each advertisement in a plurality of advertisements, Reilly provides a "set of data access tables" that provide a linked-list of advertisements assigned to each information category (*Id.*). Reilly thus maintains an "information database" in which "each advertisement is assigned to at least one of the predefined information categories" (Reilly, col. 4, line 66 - col. 5, line 1). In Reilly's approach, when a news item is viewed, the first advertisement in the linked-list associated with the news item's information category is selected and additional advertisements "are selected in rotating order among the advertisements assigned to each information category" (Reilly, col. 14, ll. 3-5). In other words, rather than providing metadata selected advertisements based on a comparison of metadata, Reilly simply accesses a queue of assigned advertisements and displays each advertisement in sequence.

In contrast to Reilly, applicants' approach, as defined by amended independent claim 1, is directed to selecting an advertisement based on a comparison of metadata associated with a selected object with metadata associated with each of a subplurality of advertisements, wherein the subplurality of advertisements itself is selected using metadata associated with the media provided to the user. Reilly, on the other hand, does not associate metadata with each of a subplurality of advertisements and makes no comparisons using metadata at all. Thus, Reilly does not show or suggest all of the elements of applicants' amended independent claims.

Moreover, as shown in Reilly's FIG. 10, news stories are displayed in response to "clicking on any of the [information] category buttons 250" and "clicking on the article advance backward and forward buttons 254 to scroll through the news items in the selected information category" (Reilly, col. 13, ll. 37-48). The advertisements are displayed based on the information category of the displayed news item. Therefore, the object selected is not the object the Examiner argues is associated with metadata. Rather, the object selected is either an information category button, an advance backward button, or an advance forward button, none of which is associated with metadata. As such, Reilly does not show or suggest selecting an advertisement based on a comparison that includes the metadata of a user selected object, as specified by applicants' claimed invention. Thus, for this reason too, Reilly does not show or suggest all of the elements of applicants' amended independent claims.

C. The Combination of Srinivasan and Reilly does not Show or Suggest Selecting an Advertisement Based on a Comparison that includes Metadata Associated with each of a Subplurality of Advertisements

For at least the reasons listed above neither Srinivasan nor Reilly discloses or suggests all of the elements of applicants' independent claims. Further, the combination of features to which these references cumulatively contribute also falls short of applicants' claimed invention. Specifically, the combination of Srinivasan and Reilly would not show or suggest selecting a subplurality of advertisements based on metadata associated with the media, and further selecting one of the subplurality of advertisements based on a comparison that includes the metadata associated with each of the subplurality of advertisements.

Accordingly, for at least the reasons listed above, applicants respectfully request that the rejections of amended independent claims 1, 18, 32, 36, 37, 43, 48, and 53 under 35 U.S.C. § 103(a) be withdrawn. Dependent claims 2, 6-10, 12-17, 20-24, 26-31, 33-34, 40-42, 45-47, 50-52, and 54-63 are also patentable at least because they depend from the patentable independent claims. For at least this reason, applicants respectfully request that the rejection of claims 2, 6-10, 12-17, 20-24, 26-31, 33-34, 40-42, 45-47, 50-52, and 54-63 under 35 U.S.C. § 103(a) also be withdrawn.

Conclusion

For at least the reasons set forth above, applicants respectfully submit that this application, as amended, is in condition for allowance. Reconsideration and prompt allowance of this application are respectfully requested.

Respectfully submitted,

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